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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,908	01/17/2006	James Grimes	16-890P/US	6236
26294 7590 09/04/2008 TAROLLI, SUNDHEIM, COVELL & TUMMINO L.L.P. 1300 EAST NINTH STREET, SUITE 1700 CLEVEVLAND, OH 44114				
EXAMINER				
MEHTA, NANCY T				
ART UNIT		PAPER NUMBER		
3692				
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09/04/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/541,908

Applicant(s)

GRIMES ET AL.

Examiner

NANCY MEHTA

Art Unit

3692

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)
- Paper No(s)/Mail Date 12/05/2005
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGregor et al. (6,650,887).

As per claims 1-15:

Have been canceled in the preliminary amendment made by the applicant.

As per claim 16: McGregor shows:

A method of enabling a transaction by a remote user for a service having an associated access number (at least in the Abstract, Summary), the method comprising the steps of:

- a) receiving a request from the user via said access number at a central processing server (Abstract, Summary, Col. 6, lines 14-31: where the access number could be the ESN or the MIN. Also see col. 5, lines 9-27: where the user can communicate with the provider, if the user so wishes. If not the user has the option of updating the service without having to communicate with the providers.);
- b) identifying the user from the request (Col. 6, lines 14-31: where the user has a unique ID number that is used to track each user);

c) determining a valid billing destination from a plurality of available billing destinations for the identified user (Col. 14, lines 46-67: where a call can involve multiple providers and so the system would need to determine billing destinations for identified users); and
d) effecting an authorization of the service for said user upon determination of a valid billing arrangement.

- McGregor shows effecting an authorization of the service for said user (col. 12, lines 45-58).
- McGregor shows the ability to activate and deactivate the phone with ease and the ability to track phone usage (col. 3, lines 10-25). However, McGregor does not explicitly show "determination of a valid billing arrangement". It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure in McGregor with the ability to validate a billing arrangement in order to allow the user to deactivate the phone when the user tracking phone usage realizes that certain charges are disputable so that the user can assist the system in detecting fraudulent activities.

Please see the examiner's reasoning in rejecting these claims below claim 21.

As per claim 17:

The method as claimed in claim 16 wherein the service is a payment for car parking.

As per claim 18:

The method as claimed in claim 16 wherein the service is the obtaining of a desired product from a vending machine.

As per claim 19:

The method as claimed in claim 16 wherein the service is the obtaining of a ticket or receipt from a ticket dispensing machine or ticket collection service.

As per claim 20:

The method as claimed in claim 16 wherein the service is the obtaining of a pass/ticket for a mass transit system.

As per claim 21:

The method as claimed in claim 17 wherein the type of car parking is selected from one or more of the following:

- a) pay and display car parking
- b) meter bay car parking, and/or
- c) virtual parking.

McGregor does not explicitly show the limitations stated in claims 17-21. However, it is obvious to one of ordinary skill in the art at the time of the invention, if the invention in McGregor can be useful in retail centers (col. 4, lines 37-50 and col. 3, lines 39-45) that the disclosure in McGregor would also be put to use in payment for car parking, obtaining of a desired product from a vending machine, obtaining of a ticket or receipt from a ticket dispensing machine or ticket collection service, obtaining of a pass/ticket for a mass transit system, type of car parking is selected from one or more of the following: a) pay and display car parking, b) meter bay car parking, and/or c) virtual

parking so that the utility of the disclosure in McGregor could be expanded and the system in McGregor could be more widely used on a commercial basis..

Intended use

In light of applicant's choice to pursue product claims, Applicants are reminded that functional recitation(s) using the word and/ or phrases "for", "adapted to" or other functional language (e.g. claim 27 recites "*for downloading and storing accrued incentives*") have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language (see e.g. *In re* Gulack, 703 F.2d 1381, 217 USPQ 401, 404(Fed. Cir. 1983, which states that although all the limitations must be considered, not all limitations are entitled to patentable weight). To be especially clear, all limitations have been considered. However, a recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to distinguish the claimed product from the prior art. If the prior art structure is capable to performing the intended use, then it reads on the claimed limitation. *In re* Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself".); *In re* Otto, 136 USPQ 458, 459 (CCPA 1963). See also MPEP § 31.06 II (c.), 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending

As per claim 22: McGregor shows:

The method as claimed in claim 17 wherein the request is received from the user over a mobile telecommunication network (abstract, summary).

As per claim 23: McGregor shows:

The method as claimed in claim 22 wherein the user is identified by means of a unique identifier specific to that user for use in the mobile telecommunication network (col. 6, lines 14-31, col. 4, lines 14-26).

As per claim 24: McGregor shows:

The method as claimed in claim 22 wherein the user is identified by means of a unique identifier specific to that user for use in the mobile telecommunication network and the unique identifier is an IMSI associated with a mobile telecommunication device associated with the user (col. 6, lines 14-31, abstract, summary: where the system in McGregor allows tracking of international calling).

As per claim 25: McGregor shows:

The method as claimed in claim 16 wherein the user is identified from the request by effecting a comparison of a user identifier specific to the user with a database of stored users (Col. 3, lines 45-55: where the CPU works as a storage hub for storing user information).

As per claim 26: McGregor shows:

The method as claimed in claim 25 wherein the database is co-located with the central processing server (Col. 3, lines 45-55: where the CPU works as a storage hub for storing user information).

As per claim 27: McGregor shows:

The method as claimed in claim 25 wherein the database is co-located with the central processing server, the method further comprising the step of, upon not effecting a matched identifier for the received user identifier within the co-located database, querying one or more remote databases, each of the queried databases being associated with a specific one of the plurality of available billing agents, so as to determine whether the received request is associatable with a subscriber to the one or more available billing agents (col. 6, lines 14-31: shows identification of user and the storage of data on a CPU (col. 3, lines 45-55)).

McGregor does not explicitly show "determine whether the received request is associatable with a subscriber to the one or more available billing agents". However, it would have been obvious to one of ordinary skill in the art to modify the disclosure in McGregor with the ability to match user identification and if no match is found to perform a further search to determine the billing agent for the user to provide value added service to customers using the system in McGregor.

As per claim 28: McGregor shows:

The method as claimed in claim 25 wherein the database is co-located with the central processing server, the method further comprising the step of, upon not effecting a matched identifier for the received user identifier within the co-located database, querying one or more remote databases, each of the queried databases being associated with a specific one of the plurality of available billing agents, so as to determine whether the received request is associatable with a subscriber to the one or more available billing agents and wherein the querying of the remote database is effected in an order based upon a "best guess" principle (col. 6, lines 14-31: shows identification of user and the storage of data on a CPU (col. 3, lines 45-55).).

McGregor does not explicitly show ""best guess" principle". However, providing a list of search terms that resemble the search query is old and well-known in the art. It would have been obvious to one of ordinary skill in the art to modify the disclosure in McGregor with the ability to match user identification and if no match is found to perform a further search and provide the user with a list of relevant search terms that resemble the search query, so that the user can browse through the list and see if one of the search terms provided relates to his/her search. This mechanism also helps account for any entry errors made while typing the search request so the searching process can be made more efficient (where the relevant search terms follow the "best guess principle").

As per claim 29: McGregor shows:

The method as claimed in claim 16 wherein the available billing destinations include one or more telecommunications operators (Col. 14, lines 46-67: where a call can involve multiple providers and so the system would need to determine billing destinations for identified users).

As per claim 30: McGregor shows:

A mobile commerce billing routing application system adapted to determine a correct billing destination from--a plurality of available billing destinations for a transaction conducted by a mobile user, the system comprising:

- a) means for receiving a transaction initiated request from a mobile user (Abstract, Summary, Col. 6, lines 14-31: where the access number could be the ESN or the MIN. Also see col. 5, lines 9-27: where the user can communicate with the provider, if the user so wishes. If not the user has the option of updating the service without having to communicate with the providers.),
- b) means for interrogating the request so as to determine whether the request is from an authorized user (Col. 6, lines 14-31: where the user has a unique ID number that is used to track each user).

McGregor does not explicitly show "interrogating the request", however, the user has the ability to interact and communicate with the provider, if the user so wishes. It is old and well-known in the art to interrogate the customer with certain user specific information in order to validate the caller so as to prevent fraudulent practices. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify

the disclosure with the ability to interrogate the user when the user gets in touch with the provider so that the identity of the user can be validated before proceeding with the call,

c) means for associating the authorized user with one of a plurality of available billing destinations, the means for associating effecting said association based on an interrogation of the request (Col. 14, lines 46-67: where a call can involve multiple providers and so the system would need to determine billing destinations for identified users),

d) means for determining whether said authorized user is authorized to conduct said requested transaction (col. 8, lines 15-39),

e) means for authorizing said transaction upon determination that the request is authorized (col. 12, lines 45-58), and

f) means for debiting said user's account (col. 12, lines 45-58).

Examiner's Note:

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANCY MEHTA whose telephone number is (571)270-3265. The examiner can normally be reached on Monday - Friday 9:00 am - 5:00 pm, alt. Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nancy Mehta

/Nga B. Nguyen/
Primary Examiner, Art Unit 3692

